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No. 06-1328

IN THE
Supreme Court of the United States

TYCO HEALTHCARE GROUP LP,
MALLINCKRODT INC., LIEBEL-FLARSHEIM COMPANY,
AND NEMOTO KYORINDO CO., LTD.

Petitioners,

v.

MEDRAD, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION

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Medrad acknowledges, as it must, that the patent reissue statute authorizes reissuance *only* where the original patent is invalidated either "'[1] by reason of a defective specification or drawing, or [2] by reason of the patentee claiming more or less than he had a right to claim in the patent.'" Opp. 9 (quoting 35 U.S.C. § 251). Medrad further acknowledges that its '648 patent was invalidated for failure to file a supplemental declaration during the examination process. Opp. 6-7. The key issue, therefore, is whether the failure to file a supplemental declaration satisfies one of the statutory requirements for reissuing a patent, namely "claiming more or less than [the patentee] had the right to claim," so that Medrad had a right to reissuance under § 251. The answer to that question, as explained in the Petition, is clearly "no."[1]

Medrad argues, as it must, that the Federal Circuit correctly answered that question in the affirmative, and did not thereby render superfluous the express language of the reissue statute. Opp. 10. Medrad is demonstrably wrong. The Federal Circuit held that "the resulting '648 reissue patent claimed more than it had a right to claim in the patent without submitting a supplemental declaration." Pet. App. 10a. But that just means that the patentee of an invalid patent *always* "claim[s] more ... than he had a right to claim in the patent," because by definition the patentee of an invalid patent does not have the right to claim *any* patent rights. If that were true, then *any* invalid patent could be reissued (at least as long as the invalidity was unintentional), and the italicized statutory language below is meaningless:

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[1] Medrad remarkably asserts that it is *undisputed* that the '648 reissue patent was defective because of Medrad "claiming more than it had a right to claim in the ['648 reissue] patent." Opp. 10, 14. That issue, of course, is the very heart of the dispute.

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, *by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

35 U.S.C. § 251 (emphasis added). That approach violates the bedrock canon that statutes should be construed so that "no clause, sentence or word shall be superfluous, void, or insignificant." Pet. 8 (internal quotation omitted; citing cases).

Medrad fails to come to grips with this point; rather, Medrad simply insists that the Federal Circuit could not have rendered the italicized language superfluous because the Federal Circuit purported to interpret that language. Opp. 10-11. But the Federal Circuit "interpreted" the italicized language out of existence. Tellingly, neither Medrad nor the Federal Circuit has suggested any scenario under which that language limits the power to reissue an invalid patent.

Medrad's approach, moreover, not only violates the plain language of the statute, but also overturns settled expectations in light of longstanding judicial interpretation of the statute. Indeed, Medrad's discussion of the cases cited by Petitioners, and Medrad's citation of additional cases, highlights—rather than disproves—the existence of conflicting precedent regarding the interpretation of Section 251's "claiming more or less than he had the right to claim" language. The following cases, as detailed in the Petition, support a appropriate reading of this language:

- *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989)
- *In re Amos*, 953 F.2d 613 (Fed. Cir. 1991)
- *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963)
- *In re Rogoff*, 261 F.2d 601 (C.C.P.A. 1958)
- *Slip Track Sys., Inc. v. Metal Lite, Inc.*, 159 F.3d 1337 (Fed. Cir. 1998)

Medrad attempts to distinguish these cases based on their facts, but Medrad cannot escape the fact that all of these cases take a narrow approach to the "claiming more or less" language, and do not interpret that language (as the Federal Circuit did below) to encompass *any* defect that leads to invalidity.

On the other hand, the following cases cited by Medrad, which are factually distinguishable from this case, support a broader view:

- *Fontjin v. Okamoto*, 518 F.2d 610, 622 (C.C.P.A. 1975) (stating in dicta that "claiming more or less than he had a right to claim in the patent" is not limited to the claims defining the invention)
- *Brenner v. State of Israel*, 400 F.2d 789, 791 (D.C. Cir. 1968) (holding that the failure to file a certified copy of a foreign patent, necessary to perfect a priority "claim," resulted in the "patentee claim[ing] less than he had the right to claim.")[2]

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[2] Contrary to Medrad's contention, the CCPA did not adopt *this* holding of *Brenner* in *Fontjin*; rather, the CCPA cited a *different* holding. In addition, the Federal Circuit did not "expressly endorse[]" the holding of Brenner in *In re Serenkin*, 479 F.3d 1359 (Fed. Cir. 2007), as Medrad asserts.

Moreover, no case cited by Medrad goes nearly as far as the Federal Circuit's holding in this case. As indicated above and detailed in the Petition, the reasoning behind the Federal Circuit's broad holding would permit reissue for *any* defect that rendered a patent wholly or partly inoperative or invalid. Such an approach would open up nearly every patent for reissuance. Medrad's argument that reissue is relatively rare misses the mark. Although fewer than 1% of all issued patents have been reissued, the Federal Circuit's decision has the potential to dramatically increase this percentage, piling additional work on an already overtaxed Patent and Trademark Office.

In another remarkable statement, Medrad contends that the '602 reissue patent is "not in identical form to the '648 patent." Yet Medrad does not dispute that it made no changes to the specification, drawings, claims, or any other part of the '648 reissue patent in obtaining the '602 reissue patent. As stated in the Manual of Patent Examining Procedure ("MPEP"), the relevant portion of which Medrad included in its Appendix, "There must be at least one error *in the patent* to provide grounds for reissue of the patent. If there is no error *in the patent*, the patent will not be reissued." Opp. App. 1 (emphasis added). The MPEP then provides a "discussion of what may be considered an error in the patent upon which to base a reissue application." Opp. App. 1. All of the errors listed in the relevant MPEP section—*i.e.*, that the claims are too narrow or too broad, that the disclosure contains inaccuracies, that the applicant failed to or incorrectly claimed foreign priority, and that the applicant failed to make reference to or incorrectly made reference to prior copending applications, Opp. App. 2-3—are errors *in the patent*. The failure to file a supplemental declaration during prosecution of the patent, on the other hand, is *not* an error *in the patent*, and Medrad cites no MPEP provision or case to the contrary.

The principle of finality is important in patent law, just as in other areas of law. Thus, Congress only authorized patent reissuance for specified defects, not for any reason or as a matter of course. Because the Federal Circuit has effectively overruled Congress' policy decision, and no other judicial avenue to correct that error exists in light of the Federal Circuit's exclusive jurisdiction over patent appeals, this Court should grant the petition.

CONCLUSION

For the foregoing reasons, as well as those set forth in the petition, this Court should grant the petition, and either set the case for plenary review or summarily reverse the decision below.

Respectfully submitted,

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